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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,833	01/11/2005	Takashi Kawakami	261638US6PCT	7215
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SCHWARTZ, DARREN B				
ART UNIT		PAPER NUMBER		
2135				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/519,833

Applicant(s)

KAWAKAMI, TAKASHI

Examiner

DARREN SCHWARTZ

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 13 August 2008 have been fully considered but they are not persuasive.

1. Applicant's argue Utsumi is directed to a license devolution apparatus capable of devolving the right to use contents such as a document, a picture and a program, which are digitized, while contributing to a protection of the copyright for the contents.¹ Utsumi describes in paragraph [0016] "that only the key and the right of using are transferred." Utsumi further describes in paragraph [0036] "secure areas 12 and 32 in each of which information as to the right to use contents and other information as to the attribute of contents are stored." Utsumi further states "it is presumed that the right to use contents, which the first storage medium 10 is entitled to, is devolved to the second storage medium 30."

In response to the previous argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

2. Applicant argues that "contrary to what is stated in the Office Action, Utsumi describes recording medium identification information that is unique to the recorded

content rather than describing recording medium identification information unique to the second recording medium.”

The Examiner disagrees. Applicant's and applicant's representative are reminded that a prior art reference must be considered in its entirety, i.e. as a whole; see *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) [MPEP: 2141.02 VI]. Utsumi teaches in ¶33, “the media ID, which is unique to the storage medium...”, in ¶37, “on the other hand, the MID area 31 of the second storage medium 30 stores therein the media ID of the second storage medium 30” and ¶44, “the media ID (the second media ID referred to in the present invention) stored in the MID area 31 of the second storage medium 30, so that the second encryption secure information is created and stored in the secure area 32 of the second storage medium 30.” Therefore, Utsumi anticipates “recording medium identification information unique to the second recording medium.”

Secondly, claims 1 and 11 recite, “various types of recording medium identification information unique to the second recording medium” and “receiving various types of recording medium identification information unique to the second recording medium,” respectively. The Examiner has broadly and reasonably interpreted “various types of recording medium identification information unique to the second recording medium” and “receiving various types of recording medium identification information unique to the second recording medium.”

3. Applicant argues that "information/file management table asserted in the Office Action to correspond to the claimed first set and the table of contents information out of the CD 55 stated in the Office Action to correspond to the claimed second set is identification information unique to the recorded content not to the second recording medium as recited in Claims 1 and 11."

The Examiner strongly disagrees. Kumagai clearly states the following (page 3 starting on line 44): "According to a fifth aspect of the present invention, there is provided a transmitting/receiving method comprising a first playback step of playing back a first storage medium; a first reading step of reading identification information of data stored in the first storage medium; a transmitting step of transmitting the identification information read in the first reading step; **a receiving step of receiving additional information stored in a second storage medium and corresponding to the identification information, the additional information being read out of the second storage medium based on the identification information transmitted in the transmitting step; and a storing step of storing the additional information received in the receiving step in correlation to the data or the identification information.**

The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 8-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi et al (U.S. Pat Pub 2001/0032088 A1), hereinafter referred to as Utsumi, in view of Kumagai (U.S. Pat 6512722 B2), hereinafter referred to as Kumagai.

Re claims 1 and 11: Utsumi teaches a content data transferring system for transferring content data selected from a first recording medium [Fig 1, elt 10: "1st STORAGE MEDIUM"] on which a plurality of content data have been recorded to a second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] (§16), the content data transferring system comprising:

a recording and reproducing apparatus configured to reproduce various types of recording medium identification information unique to the second recording medium (§14, lines 1-12) and recording content data transferred from the first recording medium [Fig 1, elt 10: "1st STORAGE MEDIUM"] to the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] (Fig 1, elts 20 & 23; §15, §16 and §47);

a reproduction control information [Fig 2, elts 41 & 42: use information] creating device configured to create reproduction control information about the content data with the second set (§44); and

a content transfer controlling device configured to transfer content data recorded on the first recording medium [Fig 1, elt 10: "1st STORAGE MEDIUM"] to the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] so as to record the content data onto the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] in accordance with the reproduction control information created in accordance with the recording medium identification information about the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] (§36, §42 and §44), the recording medium identification information being reproduced by the recording and reproducing apparatus (§37).

However, Utsumi does not teach:

first set creating means for creating a first set, the first set being used to correlate the recording medium identification information with a second set, the second set being used to categorize the content data recorded on the first recording medium in accordance with a predetermined rule;

second set creating means for creating the second set correlated with the first set;

Kumagai teaches:

first set creating means for creating a first set [Table Of Contents information/file management table] (Figs 13 & 15), the first set being used to correlate the recording

medium identification information with a second set [Table Of Contents information out of the CD 55], the second set [Table Of Contents information out of the CD 55] being used to categorize the content data recorded on the first recording medium in accordance with a predetermined rule (col 23, lines 45-63; col 24, lines 16-23; col 25, lines 20-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Utsumi reference as described for the purpose of providing TOC information to the second medium to expedite the searching of desired files on the duplicated medium.

The combination of Utsumi and Kumagai teaches:

second set creating means for creating the second set correlated with the first set (Kumagai: Fig 16; col 25, lines 20-32 and col 26, lines 7-10) (Utsumi: Fig 2, elts 41 and 42; ¶36, lines 10-14; page 4, ¶42, lines 2-7 and ¶44, lines 19-24).

Re claims 2 and 12: Utsumi in view of Kumagai teaches the content transfer controlling device is configured to transfer the created reproduction control information to the recording and reproducing apparatus so as to record the created reproduction control information onto the second recording medium (Utsumi: ¶42 and ¶44).

Re claims 3 and 13: Utsumi in view of Kumagai teaches when it has been determined that the reproduction control information newly created in accordance with the recording medium identification information reproduced from the second recording medium does not match the reproduction control information recorded on the second recording medium, content data that have not been recorded onto the second recording

medium are transferred to the second recording medium in accordance with the newly created reproduction control information (Utsumi: ¶42 and ¶51).

Re claims 4 and 14: Utsumi in view of Kumagai teaches wherein the content data recorded on the first recording medium are managed in accordance with the number of permissible record times [devolution value] for each of content data transferred from the first recording medium to other recording mediums, and wherein when each of content data which have not recorded on the second recording medium is transferred thereto, the number of permissible record times for each of the content data is decremented (Utsumi: ¶42 and ¶51).

Re claims 5 and 15: Utsumi in view of Kumagai teaches when content data that have not been recorded on the second recording medium are transferred thereto, the newly created reproduction control information is transmitted to the recording and reproducing apparatus so as to record the newly created reproduction control information onto the second recording medium (¶42, ¶44 and ¶51).

Re claims 6 and 16: Utsumi in view of Kumagai teaches content data that are not managed in accordance with the newly created reproduction control information are deleted from the second recording medium in accordance with the newly created reproduction control information (Utsumi: ¶46). Utsumi teaches the destruction of the key for decrypting said content and thus renders the content inaccessible.

Re claims 8 and 18: Utsumi in view of Kumagai teaches the reproduction control information is information with which the reproduction order of content data is controlled (Kumagai: Figs 12 & 13; col 23, lines 32-54).

Re claims 9 and 19: Utsumi in view of Kumagai teaches the second recording medium can be loaded into and unloaded from the recording and reproducing apparatus (Kumagai: Fig 1 elts 50, 80 and 82; col 7, lines 39-65).

Re claims 10 and 20: Utsumi in view of Kumagai teaches the reproduction control information is created whenever the second recording medium is loaded into the recording and reproducing apparatus (Utsumi: ¶34). Utsumi teaches a hard disc drive which is always present for use for copying media.

6. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi et al (U.S. Pat Pub 2001/0032088 A1), hereinafter referred to as Utsumi, in view of Kumagai (U.S. Pat 6512722 B2), hereinafter referred to as Kumagai, in further view of Matsushima et al (U.S. Pat Pub 2002/0161571 A1), hereinafter referred to as Matsushima.

Re claims 7 and 17: Utsumi in view of Kumagai teach all the limitations of claims 6 and 16 as previously discussed. Utsumi in view of Kumagai additionally teach each of content data recorded on the first recording medium is managed in accordance with the number of permissible record times for each of the contents that are recorded from the first recording medium onto other recording mediums (Utsumi: ¶42, ¶44 and ¶51),

However, Matsushima teaches the number of permissible record times [permitted number] for each of content data is incremented when each of the content data is deleted from the second recording medium (¶3 and ¶10). Matsushima teaches that

checked-out content that is checked-in is rendered unusable and the checked-out count is incremented.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of Utsumi and Kumagai reference to increment the permissible record times, as taught by Matsushima, for the purpose of allowing flexibility in the content management scheme while simultaneously maintaining protection on restricted content.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DARREN SCHWARTZ** whose telephone number is (571)270-3850. The examiner can normally be reached on 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./
Examiner, Art Unit 2135
/KimYen Vu/
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